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In re Application of
Daniel A. Gately
Serial No.: 09/016,641
Filed: January 30, 1998
Attorney Docket No.:

PETITION DECISION

This is in response to applicants' renewed petition under 37 CFR 1.144, filed November 22, 1999, requesting reconsideration of the petition decision of mailed September 21, 1999.

Applicant advances several reasons for reconsideration of the petition decision. Applicant objects to the "characterization" of applicant's arguments as being under M.P.E.P. 803.02 and the basing of any decision thereon. It is noted that the original petition and remarks in earlier responses to Office actions do not cite or quote M.P.E.P. 803.02, but rather refer to 35 U.S.C. 103(a) and 35 U.S.C. 121 for defining the meaning of the term "invention". Applicant argues that the concept of having more than one invention claimed within a single claim "clashes with 35 U.S.C. 103(a) and 35 U.S.C. 112" in that such a concept could force an applicant to fragment the claimed subject matter none of which completely points out and claims what applicant regards as the invention as a whole. However, M.P.E.P. 803.02 sets forth instances in which this exact scenario may be effected by the examiner. An examiner may require an election of species to facilitate examination purposes and upon proper election examine only a portion of a claim. Depending on what prior art is found, a claim may eventually be fragmented into various distinct species which are separately patentable while the genus is not patentable. The manner in which the arguments were set forth gave a perception that M.P.E.P. 803.02, although not cited, was being relied upon or rather that an election of species would have been proper as opposed to an election between distinct inventions.

Applicant's original petition contends that the examiner's restriction requirement is "illogical and inconsistent" because the examiner places several claims in two or more groups among which restriction is required. Applicant argues that a single claim cannot contain two distinct and unrelated inventions. However, such an argument, especially in the chemical compound/composition art, is not valid. There are and have been many instances in which a claim has included widely dissimilar and unrelated chemical compounds/compositions and restriction, rather than election of species, therebetween has been proper. In this particular instance, the examiner has rightfully determined that there are two different chemical compounds being claimed within a single claim and that even though they may have some structural aspects in common, such is not sufficient to consider them to be variations of the same invention.

The petition decision mailed September 21, 1999, has been reviewed in light of applicant's request for reconsideration, however the decision is not found to be in error.

Applicants' renewed petition is **DENIED**. The restriction requirement set forth by the examiner under 35 U.S.C. 121 is proper and is maintained.

Any request for reconsideration or review of this decision must be by way of a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600/2900, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 308-7922.



John Kittle
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